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**MAR 22 2005**

In re Application of:  
Randhir P.S. Thakur et al. :  
Serial No.: 09/654,093 : DECISION ON PETITION  
Filed: August 31, 2000 : TO WITHDRAW THE  
Attorney Docket No.: 94-0302.02 : HOLDING OF ABANDONMENT

This is a decision on the petition under 37 C.F.R. § 1.181 filed on March 1, 2004 requesting the withdrawal of the holding of abandonment of the above-identified application.

The petition is **GRANTED**.

A Notice of Abandonment was mailed on March 2, 2004. The Notice of Abandonment states the application is abandoned in view of the decision by the Board of Patent Appeals and Interferences rendered on November 18, 2003 and because the period for seeking court review of the decision has expired and there are no allowed claims.

A review of the Board decision indicates that the appeal was from the final rejection of claims 52-64 which were all of the claims pending in the application. On appeal, claim 60 stood rejected under 35 U.S.C. § 112 and claims 52-64 stood rejected under 35 U.S.C. § 103. The Board affirmed the rejection of claim 60 under 35 U.S.C. § 112 and the rejection of claims 52-59 under 35 U.S.C. § 103 but reversed the rejection of claims 60-64 under 35 U.S.C. § 103. Thus, there was no rejection of claims 61-64 left standing after the Board decision. However, claims 61-64 are dependent on claim 60.

MPEP § 1214.06 I (B) states in part:

"If the Board or court affirms a rejection against an independent claim and reverses all rejections against a claim dependent thereon, the examiner, after expiration of the period for further appeal, should proceed in one of two ways:

- (1) Convert the dependent claim into independent form by examiner's amendment, cancel all claims in which the rejection was affirmed, and issue the application; or
- (2) Set a 1-month time limit in which the appellant may rewrite the dependent claim(s) in independent form."

In the instant application, examiner clearly erred in not including dependent claims 61-64 in the 35 U.S.C. § 112 rejection of independent claim 60. As noted by the Board, claims 61-64 include the subject matter of claim 60 from which they directly or indirectly depend. Claims 61-64 do not remedy the lack of clarity of claim 60. Consequently, claims 61-64 are indefinite.

The Board elected not to include a 35 U.S.C. § 112 rejection of claims 61-64 as empowered to do under 37 C.F.R. § 1.196(b). Instead, the Board stated "(i)n the event of further prosecution the examiner should consider rejecting claims 61-64 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention." As noted in the petition, this language appears to be a suggestion by the Board that the examiner reopen prosecution in order to reject dependent claims 61-64 under the same § 112 basis cited against independent claim 60.

In order to correct his oversight in not including claims 61-64 in the 35 U.S.C. § 112 rejection of claim 60, examiner should have given applicant the opportunity to amend claims 60-64 to eliminate their lack of clarity. Accordingly, the Notice of Abandonment mailed March 2, 2004 is **VACATED** and the holding of abandonment is withdrawn.

The application is being forwarded to the examiner for consideration of the amendment after Board decision filed with the petition.

Any inquiry regarding this petition should be directed to Edward Westin at (571) 272-1638.

James Dwyer, Director  
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